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01 OCT 2007

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In re Application of
Blair et al.
Application No.: 10/573,666
PCT No.: PCT/GB02/03532
Int. Filing Date: 31 July 2002
Priority Date: 02 August 2001
Attorney Docket No.: 762301-1290
For: Telecommunication Interaction Analysis

DECISION ON
PETITION UNDER
37 CFR 1.137(b)

This is in response to the renewed petition under 37 CFR 1.137(b) filed on 31 January 2007.

DISCUSSION

In a decision mailed on 05 December 2006, the petition filed on 07 September 2006 was dismissed without prejudice because

With regard to requirement (3), applicants "respectfully submit that Mr. Hegebarth did not at any time intentionally abandon this application." However, the renewed petition includes a statement that "Mr. Hegebarth perhaps felt that the patent application responsibilities were not as important as the other responsibilities that he was undertaking at the time." In view of this statement, it is not clear whether Mr. Hegebarth may have intentionally deferred taking action with regard to this patent application, in favor of "other responsibilities" which were deemed "more important." To clarify this issue, petitioner should furnish a statement made by Mr. Hegebarth specifically addressing the circumstances surrounding the delay in prosecuting the application, and explaining whether or not any part of the delay was due to consciously choosing to defer action in favor of pursuing other, "more important" matters.

Moreover, petitioner has not adequately addressed (1) why the basic national fee was not paid prior to the preparation of the "informal cost estimate" in March 2004, (2) what role the "informal cost estimate" played in the subsequent delay in payment of the basic national fee, (3) what steps (if any) Andrew Pham took toward making payment of the basic national fee, (4) whether Mr. Hegebarth delegated any responsibility over handling the matter of this patent application to any other person, and (5) whether the delay between January 2006 and the filing of the initial petition in March 2006 was unintentional. Since it is not clear from the present whether the entire delay in filing the basic national fee was unintentional, it would not be appropriate to grant the requested relief at this time.

In response, petitioner states in part that

The basic national fee was not paid prior to the preparation of the "informal cost estimate" in March 2004 because Mr. Kevin Hegebarth wanted to know the cost of the preparation of the patent application to include the cost in his company's budget. While awaiting the estimate, Mr. Hegebarth overlooked the issue and

therefore the deadline was unintentionally lapsed, inadvertently allowing the application to go abandoned.

This international application became abandoned with respect to the national stage in the United States at midnight on 02 February 2004. According to petitioner's statement appearing above, Mr. Hegebarth delayed the revival and prosecution of the international application for business reasons (i.e., to await a cost estimate). MPEP 711.03(c) explains in part that

The legislative history of Public Law 97-247, § 3, 96 Stat. 317 (1982), reveals that the purpose of 35 U.S.C. 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion stating that "[u]nder this section a petition accompanied by [the requisite fee] would not be granted where the abandonment or the failure to pay the fee for issuing the patent was intentional as opposed to being unintentional or unavoidable." H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), reprinted in 1982 U.S.C.C.A.N. 770-71. A delay resulting from a deliberately chosen course of action on the part of the applicant is not an "unintentional" delay within the meaning of 37 CFR 1.137(b).

*Where the applicant deliberately permits an application to become abandoned (e.g., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). See *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989). An intentional course of action is not rendered unintentional when, upon reconsideration, the applicant changes his or her mind as to the course of action that should have been taken. See *In re Maldague*, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988).*

A delay resulting from a deliberately chosen course of action on the part of the applicant does not become an "unintentional" delay within the meaning of 37 CFR 1.137(b) because:

- (A) the applicant does not consider the claims to be patentable over the references relied upon in an outstanding Office action;*
- (B) the applicant does not consider the allowed or patentable claims to be of sufficient breadth or scope to justify the financial expense of obtaining a patent;*
- (C) the applicant does not consider any patent to be of sufficient value to justify the financial expense of obtaining the patent;*
- (D) the applicant does not consider any patent to be of sufficient value to maintain an interest in obtaining the patent; or*
- (E) the applicant remains interested in eventually obtaining a patent, but simply seeks to defer patent fees and patent prosecution expenses.*

Likewise, a change in circumstances that occurred subsequent to the abandonment of an application does not render "unintentional" the delay resulting from a previous deliberate decision to permit an application to be abandoned. These matters simply confuse the question of whether there was a deliberate decision not to continue the prosecution of an application with why there was a deliberate decision not to continue the prosecution of an application.

Here, based on petitioner's statement, it appears that Mr. Hegebarth may have deliberately delayed prosecution of the application, during the period of abandonment ("March 2004"), in order to assess the costs and benefits of continuing the prosecution. As explained at MPEP 711.03(c), delay arising from such a deliberately chosen course of action does not constitute "unavoidable" delay within the meaning of 37 CFR 1.137(b).

As stated in the Decision mailed on 05 December 2006,

To clarify this issue, petitioner should furnish a statement made by Mr. Hegebarth specifically addressing the circumstances surrounding the delay in prosecuting the application, and explaining whether or not any part of the delay was due to consciously choosing to defer action in favor of pursuing other, "more important" matters.

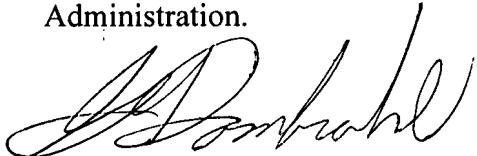
Such a statement would be appropriate should a further renewed petition be filed.

DECISION

The petition under 37 CFR 1.137(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this matter is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are available.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, P.O. Box 1450, Mail Stop PCT, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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